## REMARKS

This amendment is being filed in response to the Advisory Action mailed December 5, 2003. An Appeal Brief was due on January 19, 2004. Therefore, this response, filed with a Request for Continued Examination (RCE) and one month extension of time filed on or prior to February 19, 2004, is to be considered timely filed.

Please make of record the following comments and amendments.

### Examiner's Comments Regarding Non-Entry of Previously Filed Amendments

In the Advisory Action of December 5, 2003, the Examiner stated that the proposed amendments of the applicant's November 11, 2003 Response would not be entered because "they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. . . . "

However, applicant respectfully points that the Examiner's pending rejections are now limited to those 35 U.S.C. §112, first paragraph rejections regarding oxidizing/cyclizing agents ($Bu_4I/HI_5IO_6$) and soluble iodide. Previous rejections based on novelty and 35 U.S.C. §112 were not mentioned in the Advisory Action. The Examiner further went on to state that if the previously filed amendments were entered the 112 Second Paragraph rejection of claims 1-28 and novelty rejection of claims 10, 13-15 and objection to claims 16-24 would be deemed as obviated.

In response, applicant is resubmitting said amendments and comments in the present response to ensure that they are entered in order to overcome the previous novelty and Second Paragraph rejection. (see below) Applicant respectfully requests the Examiner to enter these comments and amendments because in light of the Examiner's comments, applicant feels said amendments

would place the pending application in better position for appeal or allowance by addressing the novelty and §112, second paragraph rejections.

In light of the Examiner's comments from the Advisory Action that the previously filed amendments have not been entered, applicant believes that the present status of the claims are as follows. Claims 1-24 are pending in the application. Claims 1-8 and 10-15 are rejected. Claims 9 and 16-24 are objected to. Claims 3 and 10 have been amended. Claims 11 and 12 have been canceled.

No claims have been allowed.

**Claim Rejections - 35 USC § 112, Second Paragraph**

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner stated that the recitation of "a reagent that oxidizes $NH_2$ to NZ" in claim 3 is indefinite as one trained in the art would not know which amino group is being referred to.

In response, applicant has amended claim 3 to specifically show which "$NH_2$" groups are oxidized to NZ." Support for this amendment can be found in claim 1 in the oxidation and cyclization of formula II to formula IA. It is also described in Scheme III of the specification (page 8, top), as well as page 8, lines 3 to 28 of the specification. In light of the amendment of claim 3, Applicant respectfully suggests that it would be clear to one of ordinary skill in the art that the $NH_2$ group adjacent to the –N-R- group is the specific -$NH_2$ involved in the oxidation of $NH_2$ to NZ and subsequent cyclization. Accordingly, in light of this amendment, applicant respectfully requests the withdrawal of this rejection.

**Claim Rejections - 35 USC § 102**

Claims 10-15 were rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Wang et al. J. Org. Chem. 62: 7288-7294, 1997.

In response, applicant has amended claim 10 so that X can no longer be 4-nitrophenyloxy group and incorporated dependent claims 11 and 12 into claim 10. Accordingly, in light of this amendment, applicant respectfully requests the withdrawal of this rejection.

In view of the foregoing, applicant submits that the application, as amended, is in condition for allowance and courteously solicits a Notice of Allowance.

**Claim Rejections - 35 USC § 112, First Paragraph**

Claims 1-8 have been rejected by the Examiner under § 112, First Paragraph. The Examiner believes that the specification, while being enabled for $Bu_4NI/H_5IO_6$ as an oxidizing/cyclizing agent, does not reasonably provide enablement for any or all oxidizing/cyclizing agents generically.

In response, applicant respectfully traverses the above rejection and presents the following comments. As stated in the previous response to the office action, the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art **without undue experimentation**. See generally, ***In re Wands***, 858 F.2d 731, 737, 8 USPQ.2d 1400, 1404 (Fed. Cir. 1998), ***Ex Parte Foreman*** 230 USPQ 546 (Bd. Of App. and Inter. 1986). ***Spectra-Physics Inc. v. Coherent Inc.***, 827 F.2d 1524, 3 USPQ.2d 1737 (Fed. Cir. 1987), ***In re Buchner***, 929, F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991) and ***In re Gay***, 309 F.2d 769, 774, 135 USPQ 311, 316 (C.C.P.A. 1962). In the instant case and as acknowledged by the Examiner, applicant has provided working examples oxidation/cyclization reagents such as, periodic acid ($H_5$ $IO_6$) and $BuNI_4$, for example, which selectively oxidize the correct amino groups. Applicant respectfully suggests that these numerous examples are sufficient to enable one to practice the claimed invention, thus satisfying the enablement requirement. As required by case law and the MPEP, these Examples, plus additional ones on page 8, lines 5 to 17 of the specification, are

more than adequate to allow one of ordinary skill in the art to practice the claimed invention without undue experimentation.

As previously pointed out, applicant respectfully maintains that given the guidance supplied by applicant's specification and further given the fact that the applicant is not required to bring to light every known example of oxidation/cyclization reagents in the applicant's specification, applicant believes that the rejected claims 1-8 enable one ordinary skill in the art to practice the invention with regard to oxidation/cyclization agents.

Claims 1-8 have been rejected by the Examiner under § 112, First Paragraph because the Examiner believes that the specification, while being enabled for $Bu_4NI$ as a soluble iodide, does not reasonably provide enablement for any or all oxidizing/cyclizing agents generically.

In response, applicant respectfully traverses the above rejection and presents the following comments. As argued in the previous response to the Examiner's office action, applicant respectfully suggests that the disclosure of $Bu_4NI$ as a working example, and the listing of numerous iodide reagents on page 8 of the specification, satisfy the enablement requirement by providing a more than adequate road map to enable one of ordinary skill in the art to practice the invention without undue experimentation. (See above cited case law and requirements of the MPEP). Applicant wishes to emphasize to the Examiner one or ordinary skill in the art would recognize that in general, iodide type reagents are by nature, soluble and that it would be routine for one of ordinary skill in the art to practice the claimed invention with any number of iodide type reagents (especially those listed by the Applicant on page 8 of the specification). Applicant also respectfully reiterates that it would be mere routine experimentation to one of ordinary skill in the art to practice the invention by using those examples on page 8 of the specification, as guidance to practice the invention with other iodide reagents.

The applicant has provided examples of oxidation/cyclization reagents and iodide groups, as required by the cited case law above. There, applicant

respectfully states that the specification and claims 1-8 and 26 meet the statutory requirements of 35 U.S.C. Section 112, first paragraph. Armed with this knowledge, one skilled in the art would be able to use the claimed process without undue experimentation. Therefore, Applicant respectfully requests the withdrawal of this rejection.

Accordingly, in light of these comments, applicant respectfully requests the withdrawal of this rejection.

No fees, other than the fee for the one-month extension of time, are believed to be due with this amendment. If any fees are determined to be due by this paper, the Commissioner is hereby authorized to deduct such fees from Account No. 19-0365.

If for any reason the Examiner believes that an interview would be helpful to resolve any remaining issues, he is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

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